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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,182	08/05/2003	Jie Jack Li	PC25274A	7102
28880	7590	11/01/2005	EXAMINER	
WARNER-LAMBERT COMPANY 2800 PLYMOUTH RD ANN ARBOR, MI 48105			RAO, DEEPAK R	
			ART UNIT	PAPER NUMBER
			1624	

DATE MAILED: 11/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,182

Applicant(s)

LI, JIE JACK

Examiner

Deepak Rao

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 are pending in the application.
- 4a) Of the above claim(s) 3,4,6,7 and 13 are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,9,11 and 14-17 are rejected.
- 7) ☒ Claim(s) 8 and 12 are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 030804 & 062005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1624

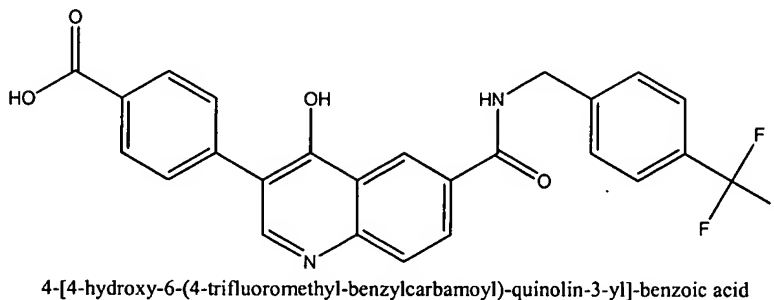
DETAILED ACTION

Claims 1-17 are pending in this application.

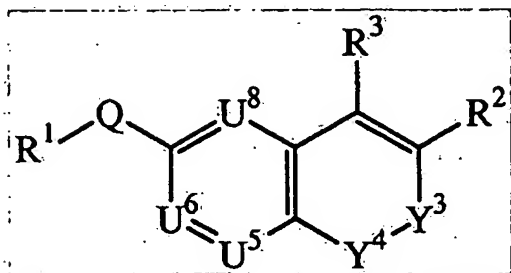
Election/Restrictions

Applicant's election without traverse of the invention of Group I in the reply filed on August 11, 2005 is acknowledged. Claim 4 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 11, 2005.

Applicant's election with traverse of the species of the ninth compound claim 12 is acknowledged. (The structural formula of the elected species is depicted below for convenience):

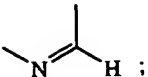


The species represents a compound of Formula I

**I**

Art Unit: 1624

wherein:

Y^3 and Y^4 taken together form the diradical  ;

U^5 , U^6 and U^8 are CH;

R^2 is 4-carboxy-phenyl;

R^3 is OH;

Q is $-N(R^6)-C(O)-$ wherein R^6 is H; and

R^1 is 4-CF₃-phenyl-CH₂-.

The elected species reads on claims 1-2, 5, 8, 10-12 and 14-17.

The guidelines in MPEP § 803.02 provide that upon examination if prior art is found for the elected species, the examination will be limited to the elected species.

Content of MPEP § 803.02 is provided here for convenience:

As an example, in the case of an application with a Markush-type claim drawn to the compound C-R, wherein R is a radical selected from the group consisting of A, B, C, D and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD or CE. The Markush-type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush-type claim and claims to the elected species shall be rejected, and claims to the non-elected species would be held withdrawn from further consideration. As in the prevailing practice, a second action on the merits on the elected claims would be final.

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. The prior art search, however, will not be extended unnecessarily to cover all nonelected species. Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. **In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.**

Art Unit: 1624

The elected species exactly was not found in the prior art and the search was expanded to compounds of Formula I wherein:

R¹ is substituted phenyl-CH₂- or phenyl-CH₂-;

R² is as defined in the claims;

R³ is H or OH;

and retaining the definitions of all other variables as defined for the elected species, art was found. Claims 1-3, 5, 8-12 and 14-17 include the subgenus to which the search is expanded. As per the instructions of MPEP § 803.02, claims 6-7 and 13 and the generic subject matter of claims 1-3, 5 and 8-11 wherein the variables of Formula I are other than as provided for the searched subgenus as indicated above, are additionally withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation:

"R² is independently selected from:

Phenyl-(C₁-C₈ alkylenyl)_m;

Substituted phenyl-(C₁-C₈ alkylenyl)_m;

Art Unit: 1624

5- or 6-membered heteroaryl-(C₁-C₈ alkylenyl)_m;Substituted 5- or 6-membered heteroaryl-(C₁-C₈ alkylenyl)_m;8- to 10-membered heterobiaryl-(C₁-C₈ alkylenyl)_m; andSubstituted 8- to 10-membered heterobiaryl-(C₁-C₈ alkylenyl)_m

wherein m is an integer 0 or 1"

in page 247, lines 6-12. There is insufficient antecedent basis for this limitation in claim 1 on which claim 10 is dependent. In claims 1 and 11, R² is defined as 'Phenyl-(C₁-C₈ alkylenyl);; etc.' Specifically, the definition of R² in all other claims does not include the segment “-(C₁-C₈ alkylenyl)_m” (i.e., with the subscript ‘ m ’).

Claim Rejections - 35 USC § 102

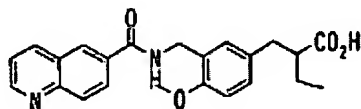
The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-2, 5, 9, 11 and 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Shinoda et al., WO 01/25181 (see U.S. Patent No. 6,884,821 which is the English equivalent).

The instant claims read on reference disclosed compound, see the compound of Example 319 (disclosed in page 319). The structural formula is depicted below for convenience:



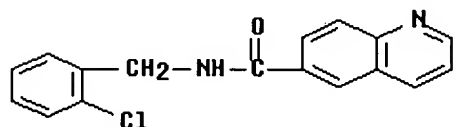
The reference compounds are taught to be useful as pharmaceutical agents, see the abstract.

Art Unit: 1624

2. Claims 1-2, 5, 9, 11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Piechaczek et al., CAPLUS Abstract 64:75701 (1966). The instant claims read on the reference disclosed compounds, see the compounds RN 6019-44-9, RN 6843-60-3 and RN 5382-48-9 in the enclosed copy of CAPLUS computer search report (structures depicted below for convenience):

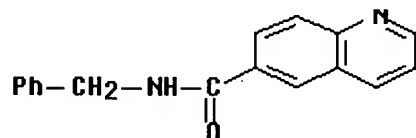
RN 6019-44-9 CAPLUS

CN 6-Quinolinecarboxamide, N-(o-chlorobenzyl)- (7CI, 8CI)



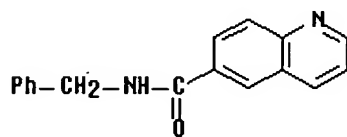
RN 6843-60-3 CAPLUS

CN 6-Quinolinecarboxamide, N-(phenylmethyl)- (9CI)



RN 5382-48-9 CAPLUS

CN 6-Quinolinecarboxamide, N-benzyl-, hydrochloride (7CI, 8CI)



● HCl

Allowable Subject Matter

Claims 8 and 12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim, **limited to the extent of the expanded and searched subgenus as defined above**, and any intervening claims.

Information Disclosure Statement

Receipt is acknowledged of the Information Disclosure Statements filed on March 8, 2004 and June 20, 2005 and copies are provided herewith.

The International Search Report for International Application PCT/IB03/03482 is also acknowledged and all the cited documents have been fully considered. The citation of the search report was removed from PTO 1449 (by drawing a line through) because the "International Search Report" itself is not a proper publication *per se* that complies with the requirements of 37 CFR 1.97 and 1.98 and therefore, will not appear on the patent as a cited document.

The Office Action (OA) from 10/264,764 is acknowledged, however, deleted from the list (by drawing a line through) as it is not a publication *per se* that complies with the requirements of 37 CFR 1.97 and 1.98 and therefore, will not appear on the patent as a cited document.

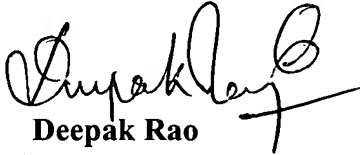
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deepak Rao whose telephone number is (571) 272-0672. The examiner can normally be reached on Tuesday-Friday from 6:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson, Acting-SPE of 1624, can be reached at (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deepak Rao
Primary Examiner
Art Unit 1624

October 27, 2005